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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,653	01/10/2000	HIDETOSHI WADA	35.C14165	3352
5514	7590	06/02/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VENT, JAMIE J	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/479,653

Applicant(s)

WADA ET AL.

Examiner

Jamie Vent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-29 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive. Applicant argues on pages 12-16 that the Squilla et al in view of Hull et al fails to disclose, teach, or fairly suggest the following limitation "a control unit adapted to judge whether or not the digital image recorded on the recording medium is already transmitted to the external recording apparatus using information corresponding to the digital image recorded on the recording medium. Squilla et al discloses a system wherein the control information is controlled through control units (figure 2 elements 83 and 76). The control units judge the recording of the picture as described in Column 6 Lines 1-50; however, is silent in regards to the judging of transmission through the using information corresponding to the digital image recorded on the recording medium. Hull et al discloses a wireless image transfer system that transfers data from the camera to the recording apparatus. It is noted in Figure 1 shows the wireless transmission as further stated Column 2 Lines 1-25 and thereby judges the information. Additionally, Hull discloses the transmission of data from the recording medium as described in Column 2 Lines 38+ wherein information is judged based on previous transmission. Although, all of applicants points are understood the examiner cannot agree and therefore the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-29 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Squilla et al (US 6,396,537) in view of Hull et al (US 5,806,005).

[claims 22, 23, 25, 26]

In regard to Claims 22, 23, 25, and 26 Squilla et al discloses an image capture apparatus that communicates with an external recording apparatus, the image capture apparatus (Figure 2 shows the communication between each system which can occur wirelessly) comprising:

- image capture unit adapted to capture a digital image (Figure 2 shows an image capturing system which comprises a digital camera 24 which acts as a capturing unit as described in Column 4 Lines 3-44);
- recording unit adapted to record the digital image captured by the image capture unit on a recording medium (Figure 2 the image is recorded onto the memory 48 for temporary storage before transmission to permanent storage in a memory of a computer, a CD, printed pictures, etc, as described in Column 5 Lines 5-17);
- a control unit adapted to judge whether or not the digital image transmitted to the recording medium is already recorded in the external recording apparatus, (Figure 2 shows the control units 83 and 76 which judge which digital images have been recorded);
- wherein said control unit automatically transmits the digital image recorded on the recording medium to the external recording apparatus if it is said judged that

the digital image recorded on the recording medium is not already transmitted to the external recording apparatus (Figure 2 further shows the transmission of the image through the desired medium when it is determined that the digital image needs to be recorded);

- wherein the control unit avoids transmitting the digital image recorded on the recording medium to the external recording apparatus if it is judged that the digital image recorded on the recording medium is already recorded in the external recording apparatus (Column 6 Lines 20-50 describes the control unit avoiding transmission if it is judged that the image has been previously recorded);
- image capture apparatus has an operation mode of automatically transmitting a digital image which is not recorded in the recording apparatus to the recording apparatus and determining whether or not to avoid reproducing a digital image which is already recorded in the recording apparatus from the recording medium (Column 4 Lines 16+ transmitting of images and Column 4 Lines 55 automatically transmitting of images from camera to the CPU while camera is in the communicating range of the image spot and as further seen in Figure 4 it is determined if the content is desired and further determining whether or not to record the image as stated in Column 8 Lines 39-56);
- image capture apparatus communicates with a recording apparatus using a wireless communication unit (Figure 2 element 20 and 82 allows wireless communication between the camera 24, CPU 10, and server 70); and
- Determining whether or not to avoid reproducing a digital image which is already recorded in the recording apparatus from the recording medium (Figure 6 shows

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the operation mode of recording unit when the pictures are received in step 140 (film for cameras are dropped off or are previously transmitted via wireless transmission) the film processor connects to the image server which judges whether to skip or delete a reproduction if the picture does not fit the desired content from the personality file, step 144 or 150. Another operation ode step 146 also provides the user the opportunity to decide whether the pictures are to be deleted or skipped before purchasing by comparison of pictures taken with database needs as further described in Column 8 Lines 1-56); however, fails to clearly disclose that the signal is sent wirelessly to the recording apparatus and the information is transmitted to the external recording apparatus using information corresponding to the digital image recorded on the recording medium.

Hull et al discloses a wireless image transfer system that transfers data from the camera to the recording apparatus. It is noted in Figure 1 shows the wireless transmission as further stated Column 2 Lines 1-25 and thereby judges the information. The wireless transmission allow for more efficient transfers between camera and recording apparatus. Additionally, Hull discloses the transmission of data from the recording medium as described in Column 2 Lines 38+. This allows for proper information to be transmitted and prevents the re-transmitting of information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the image capture device, as disclosed by Sequlla et al, and incorporate a wireless transfer between the camera and recording apparatus, as disclosed by Hull et al.

[claims 24, 27, 28, 29]

In regard to Claims 24, 27, 28, and 29, Squilla et al discloses the image communication apparatus includes a camera (Figure 1 Element 24 and further described in Column 4 Line 4).

[claims 34, 35, 36, & 37]

In regard to Claims 34, 35, 36, and 37, Squilla et al discloses the image capture apparatus wherein the control unit judges whether or not the digital image recorded on the recording medium is already recorded in the external recording apparatus using a list received from the external recording apparatus (Figure 6 shows the uploading of the image to the image server and wherein it is determined if the image is to be recorded or already recorded as further described in Column 9 Lines 8-35).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent



THAI TRAN
PRIMARY EXAMINER